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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,380	12/27/2001	Frans Eduard Janssens	JANS-0026	6297

7590 04/18/2003
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EXAMINER HABTE, KAHSA Y

ART UNIT 1624	PAPER NUMBER 8
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DATE MAILED: 04/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,380	Applicant(s) JANSSENS ET AL.	
	Examiner Kahsay Habte, Ph. D.	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Note that this restriction requirement will substitute the restriction requirement made over the telephone on March 19, 2003.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11 (in part), 15 (in part) and 18-21 (in part), drawn to monoazine compounds where $-a^1=a^2-a^3=a^4-$ in formula (I) forms a monoazine ring i.e. (a-2, a-3, a-4 and a-5) and Q = 7-8 membered ring with 1-2 nitrogens.

Group II, claim(s) 1-11 (in part), 15 (in part) and 18-21 (in part), drawn to monoazine compounds where $-a^1=a^2-a^3=a^4-$ in formula (I) forms a monoazine ring i.e. (a-2, a-3, a-4 and a-5) and Q = 5-6 membered ring with 1-2 nitrogens.

Group III, claim(s) 1-11 (in part), 15 (in part) and 18-21 (in part), drawn to monoazine compounds where $-a^1=a^2-a^3=a^4-$ in formula (I) forms a monoazine ring i.e. (a-2, a-3, a-4 and a-5) and Q = non-heterocyclic ring (b1-b4).

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Group IV, claim(s) 1-11 (in part), 15 (in part) and 18-21 (in part), drawn to compounds where $-a^1=a^2-a^3=a^4-$ in formula (I) is benzoimidazole ring i.e. (a-1) and Q = 7-8 membered ring with 1-2 nitrogens.

Group V, claim(s) 1-11 (in part), 15 (in part) and 18-21 (in part), drawn to compounds where $-a^1=a^2-a^3=a^4-$ in formula (I) is benzoimidazole ring i.e. (a-1) and Q = 5-6 membered ring with 1-2 nitrogens.

Group VI, claim(s) 1-11 (in part), 15 (in part) and 18-21 (in part), drawn to compounds where $-a^1=a^2-a^3=a^4-$ in formula (I) is benzoimidazole ring i.e. (a-2, a-3, a-4 and a-5) and Q = non-heterocyclic ring (e.g. b1-b3, b-4 when Y = C, etc.).

Group VII, claim(s) 12-14, drawn to intermediates.

Group VIII, claim(s) 16-17, drawn to complex composition.

Group IX, claim(s) 1-11 (in part), 15 (in part) and 18-21 (in part), drawn to others (such as quaternary amine, N-oxide, metal complex, etc).

3. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the technical

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features of Groups I-IX is different one from the other. For example, the technical feature of Group I is azepine ring, diazepine ring, azecine ring or diazocine ring (1-2 nitrogens in a 7-8 membered ring) and this feature is not present in other Groups. The technical feature of Group II is piperazine ring (i.e. b-6 when v=2, 6-membered ring with 2 nitrogens at 1,4-position) or pyridyl ring (b-5, when v=2, six-membered ring with one N) ring that is not present in other Groups. The technical feature of Group III is non-heterocyclic ring and is different from the other Groups. Groups I-III are different from Groups IV-VI, since the technical features of the benzoimidazole ring and monoazine ring fused to imidazole are different. In Group I-III, Q is attached to a monoazine ring, i.e. (a-2, a-3, a-4 and a-5), but in Groups IV-VI, Q is attached to benzoimidazole ring i.e. (a-1). Inventions of Group VII (intermediate) and Groups I-VI and Group IX are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful for making bis-benzoimidazoles and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Group VII is drawn to complex composition and is different from other Groups, since it has an additional ingredient (antiviral compound) that is not present in other groups.

If applicants elect Group IX, a tentative election of species is required.

A telephone call was made to Ms. Wendy Choi on April 8, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Kahsay Habte, Ph. D.
Examiner
Art Unit 1624


Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1624

KH
April 16, 2003